

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

In the specification, the paragraphs [0016], [0017], and [0023] have been amended to correct minor editorial problems, making the Examiner objections moot. Titles have also been added, as requested by the Examiner.

Claims 1-8 remain in this application. Claims 9-12 have been withdrawn as the result of an earlier restriction requirement, and applicant elected to proceed with claims 1-8 without traverse, but retains the right to present the withdrawn claims in a divisional application. New claims 13-19 are added without adding any new matter.

The examiner objected to figures 1a and 1b for having reference numbers not discussed in the specification. The specification has been amended to recite those reference numbers, making the objection moot.

The examiner objected to claims 4, 7, and 8 for having multiple dependent claims in improper form, for depending on another multiple dependent claim. These claims have been amended, making the rejections moot.

The Examiner also objected to claims 7 and 8 for being multiple independent claims in improper form for not referring to parent claims in the alternative. The Examiner is incorrect. The phrase “according to *one* of the claims x to y” is clearly alternative language, as the term “one” makes clear. Accordingly, the Examiner should withdraw the objection.

Claim 2 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. The claim has been amended, making the rejection moot.

Claims 1-3 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by Jones *et al.* (U.S. 2001/0049051). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Jones in view of D'Agostino *et al.* (U.S. 6,649,222). For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites a process for “the liquid impervious sealing of one or more of small crevices, chinks, capillaries and openings in walls of housings which occur due to an assembly of at least two structural components” where “at least certain gas permeability has to be obtained”, the process including the step of “providing a hydrophic coating on the housing wall at least in the area of the one or more of crevices, chinks, openings and capillaries”. Jones does not teach such a process

First, Jones does not teach that any crevices, chinks, capillaries or openings to be treated occur due to an assembly of at least two structural components. Thus, the reference is not analogous art, and does not teach the cited process. Accordingly, claim 1 is patentable over the reference.

Furthermore, the container 42 of Jones is described as being “formed of a flame arresting material [and is] cylindrical in shape having a cylindrical wall 44, and interior 46, and another surface 48.” (see paragraph 0078). There is no teaching that this container is comprised of at least two structural components, or that any “small crevices, chinks, capillaries” or “openings” occur as a result of the assembly of the two components. In fact, there is no disclosure of any small crevices, chinks, capillaries or openings at all. Thus, for this reason as well, claim 1 is patentable over the reference.

The Examiner argues that “if the [Jones'] coating did not seal said crevices, chinks, capillaries, or openings” then it would be “permeable to liquids”. Such an argument presupposes that the container of Jones' has any such crevices, chinks, capillaries, or openings, but there is no such teaching. Thus, there can be no teaching of making such crevices, chinks, capillaries, or openings impermeable to liquids. For example, a paper filter having no crevices, chinks, capillaries, or openings might be able to pass water without any coating treatment, but not be able to pass water with such a treatment. Thus, crevices, chinks, capillaries, or openings are not inherent to a given surface, and thus the Examiner's argument fails.

D'Agostino fails to overcome the shortcomings of Jones, and thus claim 1 is also patentable over the combination of references as well. Claims 2-8, which depend, directly or indirectly upon claim 1, are thus patentable over the references for at least the same reasons as claim 1.

Furthermore, claim 3 recites that “the housing or casing wall or its surface in the area of the one or more crevices, chinks, capillaries or and openings, shall be coated with hydrophobic nano-particles”. The Examiner argues that Jones discloses a PTFE powder, “which can be broadly interpreted to include nanoparticles” (see paragraph 0083). However, the Examiner is making an assumption that cannot hold. Jones teaches that a PTFE powder is sintered to form a hydrophobic coating. There is no teaching of whether this powder is fine, coarse, or of nano-size. Thus, the reference does not *teach* coating with hydrophobic nano-particles as recited in the claim, and thus the claim is patentable over the references for this reason as well.

Claim 5 recites that the hydrophobic coating is achieved by “coating of the housing wall with the aid of hydrated silanes or hydro-silicones or fluorine containing polycondensates”. The Examiner argues that Jones teaches a polycondensate because the reference teaches dipping the container in a PTFE solution. However, a “solution” is not necessarily a polycondensate, of which one definition is a “product of a condensation polymerization” (see, for example, <http://composite.about.com/library/glossary/p/bldef-p4078.htm?terms=condensation>). There is no teaching that the PTFE solution is a product of any polymerization process (and in fact, is likely fully polymerized in solution, as the reference merely teaches that after being dipped, the container is merely dried out), and thus claim 5 is patentable over the references for this reason as well.

New claims 18 and 19 recite additional steps that are not found in any of the cited references, and thus are patentable over those references.

Further, regarding the rejection of claim 6, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined

or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such *hindsight* is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

In this case, the Examiner is clearly providing hindsight motivation, which is improper. Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36348.

Respectfully submitted,
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